

## **REMARKS**

### **I. Status of the Application**

In response to the Notice of Abandonment dated June 14, 2004, Applicants respectfully submit that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. Applicants did not respond to the Office Action dated August 28, 2003 because the Office Action was mailed to Applicants' former counsel, Schnader Harrison Segal & Lewis, LLP, who did not provide a copy to Applicants. Accordingly, Applicants were unaware of the outstanding Office Action. Applicants are concurrently submitting herewith a Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b). Applicants respectfully request that the instant application be revived.

Claims 1-3, 5, 6 and 13-15 were pending in the application. Applicants gratefully acknowledge that claims 1, 2 and 13-15 were indicated by the Examiner to be free from the prior art (page 5 of the instant Office Action). Claims 3, 5 and 6 remained rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,204,369 or U.S. Patent No. 5,624,910.

Applicants have amended the claims to more clearly define and distinctly characterize Applicants' novel invention. Support for the amendments can be found in the specification and the claims as originally filed. Specifically, support for the amendment to claim 3 to recite "a method for increasing a concentration of an aldehyde formed during catabolism of a neurotransmitter" in a human comprising administering to the human a compound of formula I, can be found in the specification at least at page 4, lines 21-26, where Applicants teach inhibiting oxidation of aldehydes and teach the discovery of compounds that are effective in increasing the concentration of aldehydes

formed during catabolism of certain neurotransmitters that are effective in reducing alcohol consumption; at page 18, lines 12-18, where Applicants teach that accumulation of aldehydes (i.e., 5-HIAL (5-hydroxyindole-3-acetaldehyde) and DOPAL (3,4-dihydrophenyl-3-acetaldehyde)) corresponds to a suppression of ethanol intake; and in claim 3 as originally filed.

The amendments presented herein add no new matter. Applicants respectfully request entry and consideration of the foregoing amendments and remarks, which are intended to place this case in condition for allowance.

## **II. Claims 3, 5 and 6 Are Patentable Over U.S. Patent Nos. 5,204,369 and 5,264,910**

At page 2, paragraph 1 of the instant Office Action, claims 3, 5 and 6 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,204,369 or U.S. Patent No. 5,624,910. The Examiner is of the opinion that Applicant has not specifically argued, on the record, how the claimed amounts of compound used in the claimed alcohol consumption reduction method differ from the amount of identical compound used in alcohol consumption or alcohol abuse treatment methods in the prior art. The Examiner concludes that absent such arguments, the claimed increase in aldehyde concentration would have been obvious over the method of the prior art. The Examiner further is of the opinion that the discovery of an unexpected property of a compound disclosed in the prior art does not necessarily render the claimed invention unobvious since this property may be inherent in the prior art. The Examiner asserts that Applicants' argument addresses the discovery of an unexpected property of a compound already disclosed by the prior art and that the argument does not serve to distinguish the claimed method from the method disclosed by Vallee '369 and '910.

Applicants respectfully traverse this rejection based on the amended claims now presented. Claim 3 has been amended to recite a *method for increasing a concentration of an aldehyde* formed during catabolism of a neurotransmitter in a human comprising administering to the human a compound of formula I.

Applicants respectfully submit that the '369 and '910 patents, alone or in combination, fail to teach or suggest a *method for increasing a concentration of an aldehyde* formed during catabolism of a neurotransmitter, as claimed by Applicants. Applicants incorporate herein the arguments advanced in favor of patentability over the '369 and '910 patents presented in the response filed April 17, 2003. In contrast to Applicants' claimed method, The '369 and '910 patents are concerned with modifying alcohol consumption via the inhibition of ALDH-I. The '369 and '910 patents are silent regarding increasing the concentration of an aldehyde formed during catabolism of a neurotransmitter, and provide no evidence that inhibiting ALDH-I could function to increase the concentration of any aldehyde formed during catabolism of a neurotransmitter.

Applicants, however, claim a method for increasing the concentration of an aldehyde formed during catabolism of a neurotransmitter using the claimed compounds. Applicants teach that ALDH-2 is involved in neurotransmitter catabolism, and that aldehydes formed during catabolism of a neurotransmitter include 5-HIAL and DOPAL (page 9, lines 1-8). The '369 and '910 patents do not teach the involvement of ALDH-2 in either of these pathways or in *any* pathway involving any aldehyde formed during catabolism of a neurotransmitter. Thus, one of skill in the art, based on the teachings of the '369 patent or the '910 patent, would not look to increase the level of an aldehyde formed during catabolism of a neurotransmitter.

Thus, neither the '369 patent nor the '910 patent, alone or in combination, renders Applicants' claimed invention obvious. Accordingly, Applicants respectfully request that the rejection of claims 3, 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Vallee et al., U.S. Patent No. 5,204,369 or Vallee et al., U.S. Patent No. 5,624,910, be reconsidered and withdrawn.

### III. CONCLUSION

Having addressed all outstanding issues, Applicants respectfully request reconsideration and allowance of the case. To the extent the Examiner believes that it would facilitate allowance of the case, the Examiner is requested to telephone the undersigned at the number below.

Respectfully submitted,

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